



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,302	10/22/2003	Douglas M. Dillon	PD-N94026K	2255

20991 7590 05/06/2005

THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
P O BOX 956
EL SEGUNDO, CA 90245-0956

EXAMINER

AVELLINO, JOSEPH E

ART UNIT PAPER NUMBER

2143

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,302

Applicant(s)

DILLON, DOUGLAS M.

Examiner

Joseph E. Avellino

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-26 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-26 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/3/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 20-26, 29-33 are presented for examination; claims 20 and 29 independent. The Office acknowledges the cancellation of claims 27 and 28 and the addition of claim 33.

Terminal Disclaimer

2. The terminal disclaimer filed on March 3, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patent 6,839,770 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-26, 32 and 33 are rejected under 35 U.S.C. 101 as not being tangibly embodied. The invention is directed towards software per se, and not to software tangibly embodied on a computer medium. Claim 32 recites a personal computing device with the driver, however does not disclose that the driver is tangibly embodied and is executed on the personal computing device. Claims 21-26, 32, and 33 are rejected as being dependent upon claim 20.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20-26, and 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 20 and 29 recite the limitation "the Ethernet header and Ethernet checksum" which lacks antecedent basis. Correction is required. For examination purposes this phrase will be interpreted as a physical header.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 33 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,671,741 (cited

by Applicant in IDS) (hereinafter '741) in view of Attanasio et al. (USPN 5,371,852) (hereinafter Attanasio).

Attanasio discloses a driver for use in a computing device having a TCP/IP stack, said driver being configured to send an IP packet from the TCP/IP stack through an IP tunnel (the term IP tunnel can be taken as encapsulating or encoding a packet into an IP packet for use on an IP network, such as what Attanasio does with switching addresses in order for a cluster of computers to appear as a single host) (e.g. abstract; col. 6, line 55 to col. 7, line 2);

wherein the IP packet from the TCP/IP stack, which comprises an IP header, is placed within an Ethernet packet before being received by said driver (this is an inherent feature of receiving a packet since it is disclosed that the frame headers are stripped off, and since they can only be stripped off the packet when they are placed, it is inherent that they have been placed on the packet); and

wherein said driver removes the Ethernet header (i.e. stripping off the frame header) from the Ethernet packet and adds another IP header (the Office takes the term "adds another IP header" as "modifying the IP header to encompass another IP header, such as with another address/port, information) (col. 11, line 42 to col. 12, line 55; Figure 5, all).

Attanasio does not disclose generating an ARP request in connection with sending the IP packet through said driver, said driver generates an ARP response to the ARP request. Claim 1 of '741 discloses generating an ARP request in connection with sending the IP packet through said driver, said driver generates an ARP response to the

Art Unit: 2143

ARP request. It would have been obvious to one of ordinary skill in the art to combine the teaching of claim 1 of '741 with Attanasio such that the correct addresses are stored in the gateway of Attanasio, thereby ensuring that the correct routing is achieved and thereby reducing lost packets.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20-26, and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Attanasio.

Referring to claim 20, Attanasio discloses a driver for use in a computing device having a TCP/IP stack, said driver being configured to send an IP packet from the TCP/IP stack through an IP tunnel (the term IP tunnel can be taken as encapsulating or encoding a packet into an IP packet for use on an IP network, such as what Attanasio does with switching addresses in order for a cluster of computers to appear as a single host) (e.g. abstract; col. 6, line 55 to col. 7, line 2);

wherein the IP packet from the TCP/IP stack, which comprises an IP header, is placed within an Ethernet packet before being received by said driver (this is an inherent feature of receiving a packet since it is disclosed that the frame headers are

Art Unit: 2143

stripped off, and since they can only be stripped off the packet when they are placed, it is inherent that they have been placed on the packet); and

wherein said driver removes the Ethernet header (i.e. stripping off the frame header) from the Ethernet packet and adds another IP header (the Office takes the term "adds another IP header" as "modifying the IP header to encompass another IP header, such as with another address/port, information) (col. 11, line 42 to col. 12, line 55; Figure 5, all).

10. Referring to claim 21, Attanasio discloses the network is the Internet (Figure 2, ref. 120).

11. Referring to claim 22, Attanasio discloses an apparatus on the network receives the IP packet through the IP tunnel (Figure 2, ref. 210, 220).

12. Referring to claim 23, Attanasio discloses the apparatus on the network sends the received IP packet towards its destination via a network (i.e. interconnect) (Figure 2, ref. 110, 220, 210).

13. Referring to claim 24, Attanasio discloses an internet browser (i.e. software running on a node able to transmit a request, such as rlogin or NFS) running on the computing device accesses a server through the TCP/IP stack of the computing device

Art Unit: 2143

which sends a request to the server by way of said driver and the apparatus on the network (col. 13, lines 52-65).

14. Referring to claims 25 and 26, Dawson discloses the computing device is a personal computer (col. 7, lines 3-15).

15. Referring to claim 27, Dawson discloses said driver interfaces to the TCP/IP stack using an Ethernet device driver interface (col. 6, lines 23-30).

16. Claims 29-32 are rejected for similar reasons as stated above.

Response to Amendment

17. Applicant's arguments with respect to claims 20-26, 29-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

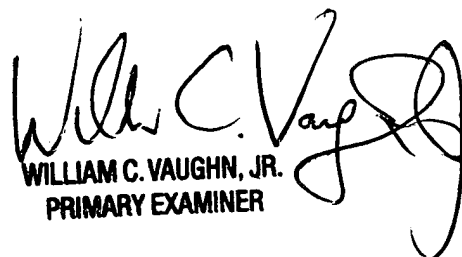
Art Unit: 2143

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A

JEA
April 19 2005


WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER